

### REMARKS

The Office Action dated July 21, 1994, has imposed a restriction requirement, further to the one imposed in paper No.2. More specifically, the Office Action has alleged that the application contains claims directed to the following patentably distinct species: phosphorous compounds classified in class 252, subclass 174.16, furyl classified in class 549, subclass 505; piperidines classified in class 546, subclass 184; epoxy classified in Class 549, subclass 512; piperazine classified in class 544, subclass 358; pyrroles classified in class 548, subclass 400+; pyrazoles classified in class 546, subclass 26+; and triazoles classified.

In support of the present Restriction Requirement, the Office Action merely concludes that these subject matter is patentably distinct.

In order to be fully responsive to the Restriction Requirement, applicants provisionally elect, with traverse, the species identified as compound 5, described in Table II on Page 203 of the instant specification. In addition, applicants have canceled, without prejudice, the subject matter from Claim 1 wherein Z is PR<sub>4</sub>. Nevertheless, applicants reserve the right to file a divisional application directed to the non-elected and canceled subject matter.

However, pursuant to 37 C.F.R. §§1.111 and 1.143 applicants hereby traverse the Examiner's requirement for a restriction, and request reconsideration in view of the following remarks.

Applicants respectfully request that this Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §§1.141-1.142. 35 U.S.C. §121 provides that the Commissioner may restrict an application when "two or more independent and distinct inventions are claimed in a single

application." (Emphasis added). Similarly, 37 C.F.R. §141(a) permits restriction conditioned upon a finding that independent and distinct inventions are found within one application. However, the present Office Action has made no such finding. More specifically, no reasoning has been proffered as the basis for the requirement of restriction.

Thus, the Restriction Requirement is not in compliance with the MPEP. It is well established that the Office Action must provide a rationale on the record to support a Restriction Requirement. More specifically, MPEP §808 states:

Every requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the invention as claimed are either independent or distinct and (2) the reasons for insisting upon restriction therebetween... (emphasis in original).

In the present case, the Office Action has failed to show or provide adequate reasoning to support the Restriction Requirement. It has not provided any reasons why the invention as claimed are independent and distinct. Moreover, it has not provided any reasoning for insisting upon restriction therebetween. The Office Action merely concludes that the various substituents are patentably distinct, without providing any arguments, rationale or evidence in support thereof. Consequently, the Restriction Requirement on two accounts is not in compliance with MPEP §808, and withdrawal thereof is respectfully requested.

In fact, applicants submit that the subject matter of the claims are not independent. The subject matter in the present application is drawn to compounds and compositions having central nervous system (CNS) activity, all having a common nucleus. This fact alone shows the interdependent aspects, not independent aspects, of the claimed subject matter. Thus, the

subject matter which the United States Patent and Trademark Office has grouped separately is not "independent and distinct" so as to justify the Restriction Requirement. It is therefore respectfully submitted that the Restriction Requirement is improper and cannot be maintained.

The Office Action also seems to suggest that a prior art search requiring search in more than one classification is sufficient criteria for maintaining a restriction to allegedly different patentable inventions. This, of course is error. It simply does not comply with the provisions under 35 U.S.C. §121. (see In re Kuehl, infra).

The classification system is also an unreliable basis for requiring restriction between claims to the various aspects of applicants' unitary invention, because the system exhibits considerable overlap in technical definitions. In particular, the definitions of subclasses in the classification system do not prevent an Examiner from basing patentability decisions, as to claims he assigned to one group, on patent references found in the subclass (es) with which he associated another group of claims.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to

different classifications is "independent and distinct" as those terms are used in 35 U.S.C. §121, which fact proves that basing restriction requirements on the classification system is improper.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that 35 U.S.C. §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to

protect a patentee's rights and to serve the public's interest in the legitimacy of issued patents, applicants respectfully urge the Examiner not to require restriction in cases such as the present application wherein various aspects of a unitary invention are claimed.

In addition, the Courts have recognized the advantages to the public interest to permit patentees to claim all aspects of their invention, as the applicants have done herein, so as to encourage the patentees to make a more detailed disclosure of all aspects of their invention. The CCPA has observed:

We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects of what they regard as their invention, regardless of the number of statutory classes involved. (emphasis added).

In re Kuehl, 456 F.2d 658, 666, 177 USPQ 250, 256 (CCPA 1973).

Furthermore, applicants respectfully request that in view of increased Official Fees and the potential limitations of applicants' financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive, and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts.

Hence, it is respectfully requested that the Examiner reconsider and withdraw the Restriction Requirement, and provide an action on the merits with respect to all of the claims.

Respectfully submitted,



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